

REMARKS

Upon entry of the present amendment, claims 67-75 will have been submitted for consideration by the Examiner while claims 53 and 59 will have been amended to eliminate minor language informalities.

In view of the herein contained remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

According to the feature of the present invention, as recited in the claims (particularly, e.g., claim 53), a communication apparatus is capable of performing both facsimile communication with a facsimile destination via a telephone network and electronic mail communication with a destination terminal via a computer network.

According to a further feature of the present invention, a detector is provided and detects identification information that is included in a non-standard signal transmitted from a facsimile destination during a facsimile protocol transmission to the facsimile destination. The identification indication indicates that the facsimile destination is capable of electronic mail communication. Finally, when the detector detects the identification information contained in the non-standard signal, a facsimile communication controller disconnects facsimile communication.

The features of the present invention can be understood from the detailed description thereof with particular reference to, inter alia, Fig. 7. Therein, when the apparatus determines that its communication partner is capable of performing an electronic mail communication in step 707, the network is disconnected in step 708 and an e-mail is transmitted. On the other hand, when step 707 indicates that the communication partner does not have the capability of electronic mail transmission, a facsimile transmission is performed in step 715. Of course, when the facsimile transmission is performed, the network is not disconnected as is evident from Fig. 7.

The combination of features recited in, e.g., Applicants claim 53, is not taught, disclosed nor rendered obvious by any of the references cited by the Examiner in any proper combination. Accordingly, reconsideration of the outstanding rejections, their withdrawal and an indication of the allowability of all the claims in the present application is respectfully requested and is now submitted to be proper.

In the outstanding Official Action, the Examiner rejected claims 53, 54, 56, 57, 59-61, 63, 64 and 66 under 35 U.S.C. § 103(a) as being unpatentable over WILLIAMS et al. (U.S. Patent No. 6,192,045) in view of SUZUKI (U.S. Patent No. 6,005,677). The Examiner rejected claims 58 and 65 under 35 U.S.C. § 103 as unpatentable over WILLIAMS et al. in view of SUZUKI and further in view of FITE, Jr. et al. (U.S. Patent No. 5,517,324).

Applicants respectfully traverse each of the above rejections and submit that they are inappropriate and that the applied references contain disclosures that are insufficient and inadequate to render unpatentable the combination of features recited in any of Applicants claims. Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

In setting forth the rejection, the Examiner asserts that WILLIAMS et al. discloses a detector that detects identification information included in a signal that is transmitted from a facsimile destination and cites column 8, lines 53-60 for this feature. Applicants respectfully submit that the Examiner is incorrect.

In particular, the noted portion of the WILLIAMS et al. disclosure does not disclose a signal containing identification information. Rather, the noted portion of the disclosure relates to a fax callback device that establishes a connection to a local exchange carrier and then transmits signaling tones received from the sending facsimile machine that correspond to the telephone number of a receiving facsimile machine. There is no indication that the noted portion of the WILLIAMS et al. disclosure is anything more than the ordinary establishment of a telephone connection to a designated phone number. This does not relate to a non-standard signal nor does it relate to a facsimile protocol transmission. Nor does the identification information indicate whether or not a facsimile destination is capable of an

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electronic mail communication. Each of these features, which are explicitly recited in Applicants claims, are not taught, disclosed nor rendered obvious by WILLIAMS et al.

According to the teachings of WILLIAMS et al., a user determines whether or not to send a facsimile over the Internet. When he wishes to do so, he adds a special code to the phone number of the receiving facsimile machine. Then, when the sending facsimile machine initiates sending of the fax, the fax callback device detects the special code and intercepts the call. The fax callback device begins the callback sequence by sending ringing signals to the sending facsimile machine. Thereafter, the fax callback device establishes a connection with the local exchange carrier as previously discussed.

Moreover, since the fax callback device, interposed between the sending facsimile machine and the local exchange carrier, transmits ringing sounds back to the sending facsimile machine, there clearly is no signal transmitted from a facsimile destination in the WILLIAMS et al. disclosure. On the other hand, a local exchange carrier 56 signals the fax callback device attached to the receiving facsimile machine of the incoming phone call by generating a ringing signal. The fax callback device answers the incoming phone call and waits to see if the incoming phone call is immediately terminated. The sending fax callback device detects that the receiving fax callback device has answered the incoming phone call and immediately terminates the phone call to avoid any charges. Thus, it is the immediate

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termination or non-termination of the call, as detected by the callback device, that determines the routing of the incoming phone call.

In direct contrast, according to the teachings of the present invention, it is the presence or absence of identification information in a non-standard signal that causes the disconnection (or not) of a facsimile communication. Yet further, Applicants note that in WILLIAMS et al., the incoming phone call is "immediately terminated". There is no indication that a facsimile protocol transmission is performed and that a non-standard signal is analyzed to determine whether there is identification information contained therein.

In the rejection, the Examiner relies upon SUZUKI for a teaching of identification information included in the non-standard signal and subsequent disconnection. It is respectfully submitted that the Examiner is incorrect. At column 5, starting at line 4, SUZUKI discusses the non-standard signal. However, in SUZUKI the standard signal is analyzed to determine whether the address information is contained therein. In response to a determination that the address information is contained in the non-standard signal, the address information is added to the telephone number conversion table so as to renew and update the same. On the other hand, when (in step 114) the address is determined not to be contained in the non-standard signal, the flow proceeds directly to step 116. However, whether or not identifying information is contained within the non-standard signal does not determine whether a disconnection of the facsimile connection occurs or not. All that is

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occurring in SUZUKI is the conversion table being renewed or not being renewed based on the existence of the address in the non-standard signal. As can clearly be seen with respect to Fig. 4 of SUZUKI, the steps 116, 117, 118, 119 and 120 all occur regardless of whether the answer to the decision in step 114 is YES or NO. Accordingly, the disclosure of SUZUKI cannot overcome the above-noted deficiencies of WILLIAMS et al.

Further with respect to the disclosure relating to Fig. 4, whether or not identification information is included in a non-standard signal does not determine whether a facsimile communication is to be disconnected or not, particularly as SUZUKI does not disclose disconnection but only "restoring" (step 120).

Yet additionally, in SUZUKI, the identification information does not indicate that a destination is capable of electronic mail communication.

Accordingly, for each of the above reasons and certainly for all of the above reasons, it is respectfully submitted that the Examiner's rejection of the pending claims is inappropriate. Thus, Applicants respectfully request reconsideration of each of the outstanding rejections and an indication of the allowability thereof.

Applicants wish to make of record a telephone interview that was conducted between Applicants undersigned representative and Examiner Pokrzywa, in charge of the present application, on December 15, 2003. During the above-noted interview, Applicants undersigned representative explained the operation of the present invention and the features

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of the claims. Applicants undersigned representative further discussed the references and pointed out the shortcomings and deficiencies of the references with respect to the claimed recitations, substantially along the lines as set forth above. At the conclusion of the interview, Examiner Pokrzywa indicated that while he understood the noted distinctions, he felt that the claims would benefit by being amended to clarify what happens after disconnection of the facsimile communication and what happens when the identification information is not included in the non-standard signal. At the conclusion of the interview, Applicants undersigned representative indicated that he would take the Examiner's comments into consideration in preparing a Response to the outstanding Official Action.

Upon review of the references and of the claim limitations, Applicants submit that there is no need to further amend the claims to define the features requested by the Examiner. However, Applicants have utilized the Examiner's suggestions as the basis for new claims which are submitted for consideration herewith. It is respectfully submitted that the claims as pending in the present application are clearly patentable over the combination of references cited by the Examiner at least for the reasons set forth above.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw each of the outstanding rejections as well as to consider and indicate the allowability of the newly submitted claims as well as the previously pending claims. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have submitted a number of new dependent claims for consideration by the Examiner. Applicants have discussed the disclosures of the references cited by the Examiner and have pointed out the substantial and significant shortcomings thereof with respect to the features recited in Applicants claims. Applicants have discussed the features of the claims and have pointed out the deficiencies and shortcomings of the references with respect to such recitations. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all of the claims in the present application and respectfully request an indication to such effect, in due course.

Applicants have made of record a telephone interview conducted between the Examiner and Applicants undersigned representative and have noted that the newly submitted claims are based on suggestions made by the Examiner during the above-noted interview. Nevertheless, Applicants submit that the claims, as pending herein, are clearly patentable.

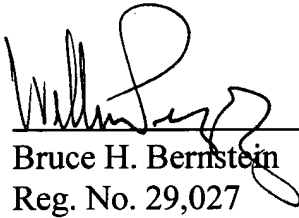
Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

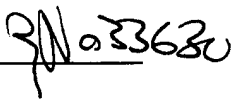


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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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